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EXAMINER

ROBERTSON, JEFFREY

ART UNIT PAPER NUMBER

1712

DATE MAILED: 12/18/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/847,004

Applicant(s)

CHILDRESS ET AL.

Examiner

Jeffrey B. Robertson

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12 is/are rejected.
- 7) ☒ Claim(s) 3,5-8 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. Claim 3 is objected to because of the following informalities: For claim 3, starting in line 6 of the claim as amended, the claim repeats the text of the claim that begins in line 4. Appropriate correction is required.
2. Claims 5-8 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. For claim 5, claim 1 as amended limits the hydrosilation catalyst to platinum catalysts, while claim 5 includes other metal catalysts such as rhodium, iridium, ruthenium, and osmium.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10, and 12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shiozawa et al. (U.S. Patent No. 4,888,436).

For claim 1, in column 3, lines 9-65, Shiozawa teaches the reaction of a secondary methallylamine with a hydridoalkoxysilane, when in the amine formula,  $R^4$  equals methyl, and where one of  $R^2$  and  $R^3$  equals alkyl. In column 4, lines 17-26, and columns 6-7, Comparative Example 1, Shiozawa teaches the hydrosilation procedure using a platinum catalyst. For claims 2 and 3, in the formula for the secondary methallylamine set forth by applicant, when  $u=0$ , general formulas [I] and [II] would anticipate applicant's formula. The formulas set forth by applicant and Huang for the hydridosilane overlap when applicant's  $R^3$  and  $R^2$  equal alkyl of 1-6 carbon atoms.

For claims 5, 6, and 8, in column 3, lines 68, Shiozawa teaches that the amount of allylamine to hydrido alkoxysilane is 1.3:1 to 1:1.3, which overlaps applicant's range. In Comparative Example 1, Shiozawa teaches that the catalyst is present in an amount to provide  $2 \times 10^{-5}$  mol of platinum, which is within applicant's range. Here also, for claims 6, 7, 9, and 12, Shiozawa teaches that the reaction takes place at a temperature of  $120^\circ\text{C}$ , which is within applicant's range and that the allylamine is added to the reaction mixture consisting of the hydrosilation catalyst and hydridoalkoxysilane at this temperature. For claims 8 and 10, Shiozawa discloses that the hydrosilation catalyst is a chloroplatinic acid solution in isopropyl alcohol.

Shiozawa does not specifically disclose the use of secondary methallylamines in the patent, however, methallylamine is specifically disclosed in column 2, line 67. In formula [I], the presence of only one  $R_1$  on the nitrogen atom, clearly indicates that Shiozawa contemplated the use of secondary amines, as evidenced by those disclosed in column 2, line 66. Therefore Shiozawa also clearly contemplated the use of secondary methallylamines as evidenced by the definition of the R groups in formula [I] as detailed above.

### ***Response to Arguments***

6. Applicant's arguments filed 10/8/02 have been fully considered but they are not persuasive. Applicant argues that Shiozawa does not teach the use of platinum catalysts. The examiner disagrees. As pointed out in the above rejection, Shiozawa does teach the use of platinum catalysts in column 4, lines 17-26, and columns 6-7, Comparative Example 1. Even though this teaching is in the form of comparative examples, the method as claimed is disclosed. Since applicant, sets forth no purity requirements in the rejected claims, ratio of isomers obtained in Shiozawa falls within the scope of the claim, particularly in view of applicant's use of the term "comprising". The specification objection, rejections under 112 2<sup>nd</sup> paragraph, and the rejection of claims 1-12 under 35 U.S.C. 102(e) over the Huang reference have been withdrawn in light of applicant's amendments and the declaration submitted under 37 C.F.R. 1.131.

### ***Allowable Subject Matter***

7. Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the

base claim and any intervening claims. For claim 11, Shiozawa fails to teach the presence of a purification step.

**Conclusion**

8. This action is non-final due to the rejection of claims 8-10 over the Shiozawa reference, those claims not having been rejected in the previous office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (703) 306-5929. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on (703) 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Jeffrey B. Robertson  
Examiner  
Art Unit 1712

JBR   
December 12, 2002